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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051170
Party	Plaintiff O2Micro International Limited
Correspondence Address	Teresa C. Tucker Grossman Tucker Perreault & Pfleger PLLC 55 South Commercial Street Manchester, NH 03101 UNITED STATES ttucker@gtpp.com
Submission	Opposition/Response to Motion
Filer's Name	Teresa C. Tucker, NH bar member
Filer's e-mail	ttucker@gtpp.com
Signature	/tct/
Date	08/12/2009
Attachments	Microsoft Word - O2M134.Obj.to.Extension.pdf (4 pages)(30231 bytes) O2M134.8.12.09.ObjtoExt.ExhibitA.pdf (4 pages)(180050 bytes) O2M134.8.12.09.ObjtoExt.ExhibitB.pdf (5 pages)(304108 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Trademark Reg. No. 2231093)
Dated: March 9, 1999)
Mark: O2)
Class: INT. 9)

O2Micro International Limited)
Petitioner) Cancellation No. 92051170
)
v.)
)
O2 Holdings Limited)
Respondent)
*

**PETITIONER’S OPPOSITION TO RESPONDENT’S REQUEST FOR EXTENSION OF
TIME TO FILE ANSWER**

Petitioner O2Micro International Ltd. (Petitioner) submits this opposition to O2 Holdings Limited’s (Respondent’s) August 6, 2009 Request for an Extension of Time to File Answer to Notice of Opposition. Petitioner respectfully submits that Respondent has not shown good cause nor relied on accurate statements in support of its said request.

I. Background

The parties in the present action are also parties to several trademark disputes in several countries including litigation in Germany, all involving the parties’ respective “O2” trademarks. A hearing in connection with the litigation in Germany was held in the District Court of Hamburg on July 16, 2009. At the conclusion of the hearing the Respondent’s European attorney indicated to Petitioner’s European attorney that a worldwide coexistence agreement may be

possible. (See Exhibit B, discussed more fully below). No further details or proposals for an agreement have been exchanged between the parties.

II. Respondent has not shown good cause for an extension

Respondent's request for an extension, filed August 6, 2009, states that Respondent's counsel received instructions from Respondent "in the last few days" regarding seeking an extension of the August 8, 2009 Answer deadline. However, Respondent's counsel contacted the undersigned on July 13, 2009 to advise that Respondent was interested in contacting the Petitioner for direct discussions. Email communications regarding same ensued between the undersigned and Respondent's counsel between that date and July 29, 2009 ending with the undersigned informing Respondent's counsel that Petitioner is not aware of any settlement negotiations other than the parties having expressed some interest in a possible discussion, and that Petitioner did not consent to suspension of the present action in view of the lack of ongoing discussions. Attached hereto as Exhibit A is a copy of the relevant email exchange. Accordingly, Petitioner submits that Respondent's counsel's suggestion that Respondent's first instructions regarding the August 18, 2009 deadline were received just days before the filing of Respondent's extension request may falsely suggest to the Board that Respondent had little time to decide how to proceed.

In addition, Respondent's counsel stated in the request that Respondent provided instructions that "the parties have indicated that they would like to discuss settlement through their European attorneys, prior to the filing of an answer." The undersigned, having had contrary information from Petitioner's European attorney, has asked Respondent's counsel for clarification of this statement and Respondent replied by email that it is "based on the statements

of our client's European attorneys." Attached hereto as Exhibit B is a Declaration of Marc F-X Groebl, Petitioner's European attorney. Petitioner submits that the parties have not begun discussions toward settlement other than to indicate an interest in same, and that the parties' European attorneys were not aware of the Answer deadline in the present action, much less cognizant of a desire to commence substantive discussions before that date.

Furthermore, a motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient. TBMP 509.01(a). Even if the factual allegations in Respondent's request were accurate, the mere suggestion that the parties are willing to entertain a settlement proposal does not justify a delay in the proceedings unless the parties both agree to the delay. *See Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (mere existence of settlement negotiations or proposals, without more, would not justify delay in proceeding with testimony); *Instruments SA Inc. V. ASI Instruments, Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (plaintiff's claim of ongoing bilateral settlement negotiations was rebutted by defendant, and no other reason for plaintiff's failure to proceed with discovery was shown).

III. Conclusion

Petitioner objects to delay in the present cancellation action, opposes the requested extension of time to file an Answer, and respectfully submits that Respondent has not shown good cause for its requested extension. Accordingly, Petitioner submits that the Request for Extension of Time to File Answer to Notice of Opposition should be DENIED.

O2Micro International Limited

Dated: August 12, 2009

By: /tct/
Teresa C. Tucker
Attorney for Petitioner
Grossman, Tucker, Perreault & Pfleger, PLLC
55 S. Commercial Street
Manchester, NH 03101
603-668-6560
Email ttucker@gtp.com

CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the subject Petitioner's Opposition to Respondent's Request for Extension of Time was served upon the Respondent via First Class mail, postage prepaid, this 12th day of August, 2009 to the following address:

Linda Kurth
Baker & Rannells PA
575 Route 28, Suite 102
Raritan NJ 08869

EXHIBIT A

3 PAGES

Terry Tucker

From: Linda Kurth [l.kurth@br-tmlaw.com]
Sent: Monday, July 13, 2009 11:57 AM
To: Terry Tucker
Cc: 'Stephen L. Baker'; 'Kelly Hnasko'
Subject: O2Micro v. O2 Holdings - Petition to cancel

Dear Ms. Tucker

We are U.S. counsel to the Registrant in the above referenced matter.

Our client has asked if it could obtain the name and contact information for the in-house counsel for O2Micro for purposes of possible direct discussions between them with regard to this matter.

Can you please advise? Thank you.

Regards,
Linda Kurth



Baker & Rannells PA
575 Route 28, Suite 102
Raritan, NJ 08869
Telephone: (908) 722-5640
Facsimile: (908) 725-7088
E-mail: l.kurth@br-tmlaw.com

This email is confidential and may be legally privileged. If you received it in error please notify us immediately. If you are not the intended recipient you should not copy it, disclose its contents to others, or use it for any purpose.

8/11/2009

Terry Tucker

From: Terry Tucker
Sent: Wednesday, July 29, 2009 1:23 PM
To: Linda Kurth; Terry Tucker
Subject: RE: O2Micro v. O2 Holdings

Dear Linda,

We are aware of the situation in the German case but at present O2Micro does not wish suspend the US cancellation action.

Regards,
Terry Tucker

-----Original Message-----

From: "Linda Kurth" <l.kurth@br-tmlaw.com>
To: "Terry Tucker" <ttucker@gtpp.com>
Cc: "Stephen L. Baker" <s.baker@br-tmlaw.com>
Sent: 7/29/09 7:15 AM
Subject: O2Micro v. O2 Holdings

Dear Terry,

Our client is 'proposing' that in light of the fact that in the German proceedings between these parties the O2 Micro lawyers specifically said that O2 Micro wanted to discuss settlement, presumably that includes all issues between them. As such, we request that you confer with your client and let us know if based on its representations of interest in negotiations it would agree to suspending here.

Thank you.

Linda Kurth
Baker & Rannells, PA

From: Terry Tucker [mailto:ttucker@gtpp.com]
Sent: Monday, July 27, 2009 3:35 PM
To: Linda Kurth
Cc: Jennifer Fessler
Subject: RE: O2Micro v. O2 Holdings

Dear Linda,
Please let me know what terms your client is proposing and then my client can consider whether negotiations are of interest.
Regards,
Terry Tucker

-----Original Message-----

From: "Linda Kurth" <l.kurth@br-tmlaw.com>
To: "Terry Tucker" <ttucker@gtpp.com>
Sent: 7/27/09 10:34 AM
Subject: RE: O2Micro v. O2 Holdings

Dear Terry

Would your client agree to suspending the cancellation proceedings pending negotiations?

Regards
Linda Kurth

From: Terry Tucker [mailto:ttucker@gtpp.com]
Sent: Monday, July 27, 2009 12:05 PM
To: Linda Kurth
Cc: Jennifer Fessler
Subject: RE: O2Micro v. O2 Holdings

Linda,
Thank you for following up. O2Micro is not interested in direct discussions at this time. If O2Holdings wishes to present a proposal toward resolution, I will pass it along to my client.

Regards,
Terry Tucker

-----Original Message-----

From: "Linda Kurth" <l.kurth@br-tmlaw.com>
To: "Terry Tucker" <ttucker@gtpp.com>
Cc: "Kelly Hnasko" <k.hnasko@br-tmlaw.com>
Sent: 7/27/09 9:39 AM
Subject: O2Micro v. O2 Holdings

Dear Ms. Tucker

We have not heard from you regarding contact information so that our client can directly contact that contact person to discuss the issues and settlement. Can you indicate if this information will be forthcoming?

Regards,
Linda Kurth

8/11/2009



Baker & Rannells PA
575 Route 28, Suite 102
Raritan, NJ 08869
Telephone: (908) 722-5640
Facsimile: (908) 725-7088
E-mail: lkurth@br-tmlaw.com

This email is confidential and may be legally privileged. If you received it in error please notify us immediately. If you are not the intended recipient you should not copy it, disclose its contents to others, or use it for any purpose.

8/11/2009

EXHIBIT B

4 PAGES

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Trademark Reg. No. 2231093)
Dated: March 9, 1999)
Mark: O2)
Class: INT. 9)

O2Micro International Limited)
Petitioner) Cancellation No. 92051170
)
v.)
)
O2 Holdings Limited)
Respondent)
*

DECLARATION OF MARC F-X GROEBL

I, Marc F-X Groebl, pursuant to 28 U.S.C. §1746, declare as follows:

1. I am over the age of 18 years and am fully competent to make this declaration. I make the following statements based on personal knowledge and if called to testify to them could and would do so.
2. I am an attorney with the Munich, Germany office of the law firm of Howrey LLP, located at Gmunder Strasse 53, D-81379 Munich, Germany, and I represent O2Micro International Ltd in connection with a trademark litigation action filed by O2 Holdings Ltd in the District Court of Hamburg, case number 327 O 514/08 involving the trademark "O2" among others (hereinafter "the German action").

3. On July 16, 2009 I attended and participated in a hearing in the German action. At the conclusion of the hearing I had a conversation with Dr. Philipp Neuwald, counsel for O2 Holdings Ltd in the German action.
4. In the course of said conversation, Dr. Neuwald expressed interest in the possibility of a possible worldwide coexistence agreement between the parties. In my letter of August 7, 2009, I suggested to the attorney of the other side that he present us with a proposal. As of this date I have not received further contact from Dr. Neuwald or other representatives of O2 Holdings Ltd with respect to a proposal for an agreement.
5. I have read the content of the attached "Request for Extension of Time to File Answer to Notice of Opposition" (Exhibit A) including the statement "the parties have indicated they would like to discuss settlement through their European attorneys, prior to the filing of an answer." I have no recollection or knowledge of the parties having intended to discuss settlement by a particular date or occurrence, and in particular, there was no mention during the July 16, 2009 conversation with Dr. Neuwald that a proposal or other discussions would occur prior to the filing of an answer in the subject US Trademark Cancellation Action. Furthermore, I was not aware at that time that a Petition for Cancellation had been filed.
6. I declare under penalty of perjury of the laws of the United States of America that the foregoing statements are true and correct to the best of my knowledge.


Marc F-X Groeb1

Date: 12/8/09

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

O2Micro International Ltd.

Cancellation No. 92051170

Petitioner,

Mark: O2

v.

Reg. No. 2231093

O2 Holdings, Ltd.

Registrant.

REQUEST FOR EXTENSION OF TIME TO FILE ANSWER
TO NOTICE OF OPPOSITION

Upon receipt of the Petition to Cancel, we advised our client, the Registrant, of the necessity of filing a timely answer to avoid a default. Registrant responded in the last few days and instructed us that the parties have indicated that they would like to discuss settlement through their European attorneys, prior to the filing of an answer.

Accordingly, Registrant requests an extension of time of thirty days to respond to the Petition to Cancel, during which time Registrant will explore the possibility of discussing settlement with the Petitioner. This request is not being submitted merely for the purposes of delay, but to allow Registrant a modest extension of time while it attempts to acquire information and settle the proceeding, thus conserve judicial resources.

Respectfully submitted,

/s/Linda Kurth

Stephen L. Baker

Linda Kurth

Attorneys for Applicant

575 Route 28, Suite 102

Raritan, New Jersey 08869

Dated: August 6, 2009

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Request for an Extension of time to answer the Petition to Cancel, in re: O2Micro International, Ltd. v. O2 Holdings, Ltd., Cancellation No. 92050117, was forwarded by email and first class postage pre-paid mail by depositing the same with the U.S. Postal Service on this 6th day of August, 2009, to the attorney for the Petitioner at the following address:

Teresa C. Tucker
Grossman, Tucker, Perreault & Pfleger, PLLC
55 S. Commercial Street
Manchester, NJ 03101
ttucker@gtpp.com

/s/Linda Kurth
Linda Kurth

DATED: August 6, 2009